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10/616,146

07/08/2003

John R. Wullert II

APP 1468

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06/17/2005

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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/616,146

Applicant(s)

WULLERT, JOHN R.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7-16, 18, 19 and 21-28 is/are rejected.
- 7) ☒ Claim(s) 3, 6, 17 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. **Claim(s) 5** is objected to because of the following informalities: line 1 “wherein in” should be “wherein”. Correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim(s) 1, 2, 4, 12-16, 18 and 26-28** are rejected under 35 U.S.C. 102(b) as being anticipated by Boltz et al. (US 6,246,889 B1).

Regarding **claim(s) 1**, Boltz discloses a system to delay answering a call made to a cellular phone (FIG. 1 and column 1, lines 7-10), the system comprising:

means to record a message to be provided to a caller making calls to the cellular phone (FIG. 3 and column 4, lines 39-51) [The special button 306A of the mobile station 20 is utilized to record a message to be transmitted to the caller when a call is placed on delay answering, thereby a means to record a message to be provided to a caller making calls to the cellular phone]; and

means to instruct the message to be played to the caller (FIG. 3 and column 4, lines 10-21) [The subscriber presses the special button 306A to request a delay

answering from the MS 20, the application module 200 accesses the database 206 to retrieve the prerecorded message and plays it to the caller via the announcement module 204 to the caller, thereby a means to instruct the message to be played to the caller];

wherein the caller is connected, the message is played and after the message is played the caller remains connected (FIG. 3 and column 4, lines 21-31) [The incoming line 201 is connected to the announcement module 204 where the prerecorded message is transmitted to the caller and the incoming line remains connected until the subscriber answers the call, thereby the message is played and after the message is played the caller remains connected].

Regarding **claim(s) 2**, Boltz discloses a system to delay answering a call made to a cellular phone, wherein the system is a distributed system (FIG. 1 and column 4, lines 4-9) [The delayed answering database 206 can be integrated and connected to several MSCs 14, thereby the system is a distributed system].

Regarding **claim(s) 4**, Boltz discloses a system to delay answering a call made to a cellular phone, wherein the means to record is contained in the cellular phone (FIG. 3 and column 5, lines 25-29) [The MS 20 includes a memory 302 containing prerecorded messages].

Regarding **claim(s) 12**, Boltz discloses a system to delay answering a call made to a cellular phone, wherein the cellular phone user can interrupt the message at any time and be connected to the caller (FIG. 2 and column 4, lines 32-38) [The MSC 14 upon receiving the signal requesting answering a call from the MS 20, connects the incoming line to establish communication, thereby the cellular phone user can interrupt the message at any time and be connected to the caller].

Regarding **claim(s) 13**, Boltz discloses a system to delay answering a call made to a cellular phone, wherein means to record includes storage for a plurality of messages (FIG. 2 and column 4, lines 4-9) [The delaying answering database 206 includes cross-references directory numbers with prerecorded messages].

Regarding **claim(s) 14**, Boltz discloses a system to delay answering a call made to a cellular phone, wherein the system further includes means to play different messages in response to predetermined preferences (FIG. 2 and column 4, lines 4-9) [The delay answering database 206 has cross-references directory numbers of mobile stations with prerecorded messages, thereby the system further includes means to play different messages in response to predetermined preferences].

Regarding **claim(s) 15**, Boltz discloses a method of delaying answering a call made to a cellular phone (FIG. 1 and column 1, lines 7-10), the method comprising the steps of:

recording a message to be provided to a caller making calls to the cellular phone (FIG. 3 and column 4, lines 39-51) [The special button 306A of the mobile station 20 is utilized to record a message to be transmitted to the caller when a call is placed on delay answering, thereby recording a message to be provided to a caller making calls to the cellular phone]; and

instructing the message to be played to the caller (FIG. 3 and column 4, lines 10-21) [The subscriber presses the special button 306A to request a delay answering from the MS 20, the application module 200 accesses the database 206 to retrieve the prerecorded message and play it to the caller via the announcement module 204 to the caller, thereby instructing the message to be played to the caller];

connecting the caller (FIG. 3 and column 4, lines 21-31) [The incoming line 201 is connected to the announcement module 204, thereby connecting the caller];

playing the message to the caller (FIG. 3 and column 4, lines 21-31) [The prerecorded message is transmitted to the caller, thereby playing the message to the caller];

maintaining the connection with the caller after the message has been played (FIG. 3 and column 4, lines 21-31) [The incoming line 201 remains connected until the subscriber answers the call, thereby maintaining the connection with the caller after the message has been played].

Regarding **claim(s) 16**, Boltz discloses a method of delaying answering a call made to a cellular phone, wherein the method is carried out on a distributed system

(FIG. 1 and column 4, lines 4-9) [The delayed answering database 206 is integrated and connected to several MSCs 14, thereby the system is a distributed system].

Regarding **claim(s) 18**, Boltz discloses a method of delaying answering a call made to a cellular phone, wherein the step of recording comprises making the recording into means contained in the cellular phone (FIG. 3 and column 5, lines 25-29) [The MS 20 includes a memory 302 containing prerecorded messages].

Regarding **claim(s) 26**, Boltz discloses a method of delaying answering a call made to a cellular phone, further including the steps of:

interrupting the message at any time (FIG. 2 and column 4, lines 32-38) [The MSC 14 upon receiving the signal requesting answering a call from the MS 20, connects the call to the caller, thereby interrupting the message at any time]; and

connecting the caller to the cellular phone (FIG. 2 and column 4, lines 32 38) [The MSC 14 connects the incoming line to establish communication, thereby connecting the caller to the cellular phone].

Regarding **claim(s) 27**, Boltz discloses a method of delaying answering a call made to a cellular phone, wherein the step of recording comprises recording a plurality of messages (FIG. 2 and column 4, lines 4-9) [The delaying answering database 206 includes cross-references directory numbers with prerecorded messages].

Regarding **claim(s) 28**, Boltz discloses a method of delaying answering a call made to a cellular phone, further comprising the step of:

playing different messages in response to predetermined preferences (FIG. 2 and column 4, lines 4-9) [The delay answering database 206 has cross-references directory numbers of mobile stations with prerecorded messages, thereby play different messages in response to predetermined preferences].

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claim(s) 5, 7-11, 19 and 21-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boltz in view of Deutsch et al. (US 6,028,922 A).



Regarding **claim(s) 5**, Boltz as applied to **claim(s) 1** above differ from **claim(s) 5** in that it fails to disclose the system is a centralized system.

Deutsch, in the same field of endeavor, teaches wherein the system is a centralized system (FIG. 1 and column 2, lines 38-59) [The switching system 2 uses the calling party number to query a database, thereby the system is a centralized system].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the system to be a centralized system so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 7**, Boltz in combination with Deutsch as applied to **claim(s) 5** above differ from **claim(s) 7** for the means to record is located in a device peripheral to the cellular phone.

Furthermore Deutsch teaches the means to record is located in a device peripheral to the cellular phone (FIG. 1 and column 2, lines 50-61) [The switching system 2 accesses a voice response system 8 where the voice message for the caller are saved, thereby the means to record is located in a device peripheral to the cellular phone].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the means to record is located in a device peripheral to the cellular phone so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 8**, Boltz in combination with Deutsch as applied to **claim(s) 7** above differ from **claim(s) 8** for the system is an in-band signaling system and the call is established as a three way bridge.

Furthermore Deutsch teaches the system is an in-band signaling system and the call is established as a three way bridge between the caller, the cellular phone and the peripheral device (FIG. 1 and column 4, lines 13-43) [The voice response system 8 plays the announcement to the calling party and instructs the switch to park the call and transmits the parked call message to the called party, thereby the system is an in-band signaling system and the call is established as a three way bridge between the caller, the cellular phone and the peripheral device].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables to establish a three way bridge between the caller, the cellular phone and the peripheral device so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 9**, Boltz in combination with Deutsch as applied to **claim(s) 8** above differ from **claim(s) 9** for the cellular phone user can interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected.

Furthermore Deutsch teaches the cellular phone user can interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button and send a message to the switch system 2 informing the park call location provided by the voice response unit 8, thereby the called party can interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the called party to interrupt the message at any time and stay connected to the caller and the peripheral device will be

disconnected so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 10**, Boltz in combination with Deutsch as applied to **claim(s) 7** above differ from **claim(s) 10** for the system is an out-of-band signaling system and the call is established a connection between the caller and the peripheral device.

Furthermore Deutsch teaches the system is an out-of-band signaling system and the call is established a connection between the caller and the peripheral device (FIG. 1 and column 4, lines 4-12) [The switching system 2 forwards the call to the voice response system 8, thereby the system is an out-of-band signaling system and the call is established a connection between the caller and the peripheral device].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables to establish a connection between the caller and the peripheral device so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 11**, Boltz in combination with Deutsch as applied to **claim(s) 10** above differ from **claim(s) 11** for the cellular phone user can interrupt the message at any time and be connected to the caller and the peripheral device will be disconnected.

Furthermore Deutsch teaches the cellular phone user can interrupt the message at any time and be connected to the caller and the peripheral device will be disconnected (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button and send a message to the switch system 2 informing the park call location provided by the voice response unit 8, thereby the called party can interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the called party to interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 19**, Boltz as applied to **claim(s) 15** above differ from **claim(s) 19** in that it fails to disclose the system is a centralized system.

However, Deutsch, in the same field of endeavor, teaches, wherein the method is carried out on a centralized system (FIG. 1 and column 2, lines 38-59) [The switching system 2 uses the calling party number to query a database, thereby the system is a centralized system].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the system to be a centralized system so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 21**, Boltz in combination with Deutsch as applied to **claim(s) 19** above differ from **claim(s) 21** for the step of recording comprises making the recording into a device peripheral to the cellular phone.

Furthermore Deutsch teaches the step of recording comprises making the recording into a device peripheral to the cellular phone (FIG. 1 and column 2, lines 50-61) [The switching system 2 accesses a voice response system 8 where the voice message for the caller are saved, thereby the means to record is located in a device peripheral to the cellular phone].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the means to record is located in a device peripheral to the cellular phone so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 22**, Boltz in combination with Deutsch as applied to **claim(s) 21** above differ from **claim(s) 22** for the step of connecting comprises establishing a three way bridge.

Furthermore Deutsch teaches the step of connecting comprises establishing a three way bridge between the caller, the cellular phone and the peripheral device (FIG. 1 and column 4, lines 13-43) [The voice response system 8 plays the announcement to the calling party and instruct the switch to park the call and transmits the parked call message to the called party, thereby the system is an in-band signaling system and the call is established as a three way bridge between the caller, the cellular phone and the peripheral device].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables to establish a three way bridge between the caller, the cellular phone and the peripheral device so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 23**, Boltz in combination with Deutsch as applied to **claim(s) 22** above differ from **claim(s) 23** for interrupting the message at any time, maintaining the connection between the caller and the cellular phone and disconnecting the peripheral device.

Furthermore Deutsch teaches interrupting the message at any time (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button, thereby interrupting the message at any time];

maintaining the connection between the caller and the cellular phone (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button and send a message to the switch system 2 informing the park call location, thereby maintaining the connection between the caller and the cellular phone]; and

disconnecting the peripheral device (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button and sends a message to the switch system 2 informing the park call location provided by the voice response unit 8, thereby disconnecting the peripheral device].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the called party to interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).



Regarding **claim(s) 24**, Boltz in combination with Deutsch as applied to **claim(s) 21** above differ from **claim(s) 24** for the step of connecting comprises establishing a connection between the caller and the peripheral device.

Furthermore Deutsch teaches the step of connecting comprises establishing a connection between the caller and the peripheral device (FIG. 1 and column 4, lines 4-12) [The switching system 2 forwards the call to the voice response system 8, thereby establishing a connection between the caller and the peripheral device].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables to establish a connection between the caller and the peripheral device so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

Regarding **claim(s) 25**, Boltz in combination with Deutsch as applied to **claim(s) 24** above differ from **claim(s) 25** for interrupting the message at any time, connecting the caller to the cellular phone and disconnecting the peripheral device.

Furthermore Deutsch teaches interrupting the message at any time (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button, thereby interrupting the message at any time];

connecting the caller to the cellular phone (FIG. 1 and column 4, lines 43-62)  
[The called party wishes to retrieve the parked call by depressing a button and send a

message to the switch system 2 informing the park call location, thereby connecting the caller to the cellular phone]; and

disconnecting the peripheral device (FIG. 1 and column 4, lines 43-62) [The called party wishes to retrieve the parked call by depressing a button and send a message to the switch system 2 informing the park call location provided by the voice response unit 8, thereby disconnecting the peripheral device].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Boltz using the switching system as taught by Deutsch.

This modification of the invention enables the called party to interrupt the message at any time and stay connected to the caller and the peripheral device will be disconnected so that the user would have the convenience to handle the incoming call more professionally and efficiently (Deutsch: column 5, lines 36-40).

### ***Allowable Subject Matter***

7. **Claim(s) 3, 6, 17 and 20** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim(s) 3, 6, 17 and 20**, the prior art at this time fails specifically to disclose the means to instruct is selected from the group consisting of a button on the cellular phone, a keypad entry to the cellular phone, an entry on a calendar, an entry on a clock, an entry into a location device, a telephone order, an electronic message, a web page interface, interaction with a service representative, and combinations thereof.


### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GERALD GAUTHIER**  
**PATENT EXAMINER**

Gerald Gauthier  
Examiner  
Art Unit 2645

g.g.  
June 8, 2005